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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : ROGER MINORETTI, ALBINO TRIACA, BEAT  
MERZ, RETO BAUMGARTNER, THOMAS BRUDERER  
and ROGER VON MENTLEN

Serial No. : 10/502,213

Filed : July 21, 2004

For : DISTRACTING DEVICE FOR ORTHODONTIC/  
OROSURGICAL PURPOSES ON THE LOWER JAW

Art Unit : 3732

Examiner : Ralph A. Lewis

Customer No. : 010037

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October 29, 2007

MAIL STOP PETITIONS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

RENEWED PETITION TO REVIVE UNDER 37 CFR §1.137(b)

ADDITIONAL FEE:

Please charge any insufficiency of fee, or credit any  
excess, to Deposit Account No. 50-0427.

This is a request for reconsideration of the Decision  
on Petition issued September 13, 2007 (copy enclosed).

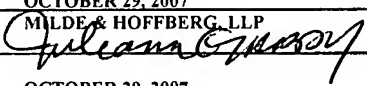
The aforementioned Decision dismissed applicants' Petition to Revive the above-identified patent application, which was filed on June 14, 2007. The reason for the dismissal was that applicants' Amendment, which accompanied the Petition, did not place the application in condition for allowance. Enclosed with the Petition was an Advisory Action stating that the proposed amendments to the claims raised "new issues" and were not "deemed to place the application in better form for appeal."

Enclosed herewith is a Request for Continued Examination (RCE) and a check for the requisite fee (\$405).

Reconsideration of applicants' Petition to Revive is respectfully requested so that the examination of this application may be continued, based on applicants' Amendment filed June 14, 2007.

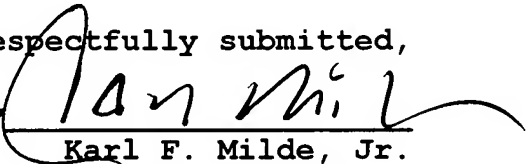
MILDE & HOFFBERG, LLP  
10 Bank Street - Ste. 460  
White Plains, NY 10606  
(914) 949-3100

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on

OCTOBER 29, 2007  
MILDE & HOFFBERG, LLP  
By   
Date OCTOBER 29, 2007

Respectfully submitted,

By

  
Karl F. Milde, Jr.  
Reg. No. 24,822



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OFFICE OF PETITIONS

In re Application of  
Minorette et al.  
Application Number: 10/502213  
Filing Date: 09/17/2004  
Attorney Docket Number: GRIMM  
235-KFM

DECISION ON PETITION

*Req Reconsideration*  
*11-13-07*

This is a decision on the petition under 37 CFR 1.137(b),<sup>1</sup> filed on 14 June, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on 17 February, 2007, for failure to file a timely reply to the final Office action mailed on 16 November, 2006, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply

<sup>1</sup> Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

were filed in accordance with 37 CFR 1.136(a). Notice of Abandonment was mailed on 18 June, 2007.

The petition lacks the required reply. The only proper reply to a final Office action is a Notice of Appeal and fee, Request for Continuing Examination and submission under 37 CFR 1.114, a continuing application, or an amendment placing the application in *prima facie* condition for allowance. The examiner has determined that the amendment filed on 14 June, 2007, does not place the case in *prima facie* condition for allowance. An Advisory Action Before the Filing of An Appeal Brief is enclosed for petitioners' information.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply.<sup>2</sup> The extension request filed on 14 June, 2007, was submitted after 16 May, 2007, which was the last day of the three (3) month shortened statutory period for reply to the Office action mailed on 16 November, 2006, and therefore is unnecessary. The extension of time fee paid on 14 June, 2007, will be credited to counsel's deposit account as authorized.<sup>3</sup>

Further correspondence with respect to this matter should be addressed as follows:

By mail:           Mail Stop Petition  
                  Commissioner for Patents  
                  P.O. Box 1450  
                  Alexandria, VA 22313-1450.

By FAX:           (571) 273-8300  
                  Attn: Office of Petitions

By hand:          Customer Service Window  
                  Mail Stop Petition  
                  Randolph Building  
                  401 Dulany Street  
                  Alexandria, VA 22314

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<sup>2</sup> See *In re Application of S.*, 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

<sup>3</sup> Additionally, as a three (3) month shortened statutory period was set by the final Office action, a maximum three (3) month extension of time could be obtained to respond to the final Office action.

Application No. 10/502,213

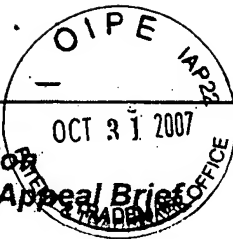
3

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.

A handwritten signature in cursive script, appearing to read "D. Wood".

Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

Encl: Advisory Action Before the Filing of an Appeal Brief



**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/502,213

Applicant(s)

MINORETTI ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

**-The MAILING DATE of this communication appears on the cover sheet with the correspondence address -**

THE REPLY FILED 14 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: 10-15 and 18-23.  
Claim(s) rejected: 1-9, 16 and 17.  
Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

  
Ralph A. Lewis  
Primary Examiner  
Au 3732

Continuation of 3. NOTE: The proposed amendment to claim 1 changes the claimed invention from an "appliance" to a "kit of parts," adds a second connecting means to the first module and adds a paragraph of previously unclaimed material to the claim. While the proposal may be allowable, it has not been previously searched or considered in view of the cited prior art.